

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 13 and 18 have been amended, claims 14-16 have been cancelled without prejudice, and new claims 21-25 have been added. Support for the new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC Section 102(b)

Claims 13 and 17-20 have been rejected under 35 USC Section 102(b), as being anticipated by U.S. patent 3,609,451 to Edgerly, Jr. et al. ("Edgerly"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 13 and 18 and features in the other claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under 102(b), "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385*. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International*

Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 13 (amended), and its dependent claims 17 and 21-25, are patentably distinguishable over the cited reference because claim 13 emphasizes the novel features of the present invention in which the light controller includes an input configured to receive from an external device an illumination command specifying the predetermined illumination. In this regard, claim 13 recites a lighting arrangement for providing a predetermined illumination on an object illuminated by a varying ambient light which includes:

“a light source disposed in optical proximity to the object for illuminating the object with a supplied light of a certain intensity in response to a light control signal;

an illumination sensor disposed in optical proximity to the object for detecting the total illumination resulting from both the supplied light and the ambient light, the illumination sensor producing an illumination signal proportional to the total illumination; and

a light controller electrically connected to the illumination sensor and the light source, the light controller having a negative feedback circuit for producing the light control signal in response to the illumination signal so as to maintain the predetermined illumination on the object, the light controller further including an input configured to receive from an external device an illumination command specifying the predetermined illumination.” (emphasis added)

The Edgerly reference discloses an “automatic illumination control system responsive to total illumination” (Title) in which “an adjustable resistance 14 enables a user to select the desired quantity of light which is to be maintained substantially constant” (col. 2, lines 64-66). However, selection of the desired quantity of light is performed in a manual, rather than programmatic, manner; “the adjustable control 14 may be positioned on a wall or other convenient location” (col. 2, lines 73-74; Fig. 1) for a user to walk over to and adjust manually.

Significantly, the Edgerly reference says nothing about having an input configured to

receive from an external device an illumination command specifying the predetermined illumination as recited in Applicants' claimed invention. The Edgerly system is not a programmable one, nor does the Edgerly reference suggest the desirability of having such programmable features. The manual system of the Edgerly reference is directed to illuminating an area such as a room (Fig. 1; col. 1, lines 57-73), not to providing computer-controlled illumination for use in conjunction with test systems as with Applicants' invention.

Therefore, the novel features of the present invention are not anticipated by the Edgerly reference in that the element of an input configured to receive from an external device an illumination command specifying the predetermined illumination is absent from the Edgerly reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 18 (amended), and its dependent claims 19-20, are patentably distinguishable over the cited reference because claim 18 emphasizes the novel features of the present invention in which the method includes receiving via a programming interface an illumination command that specifies the predetermined illumination. In this regard, claim 18 recites a method for illuminating an object with a predetermined illumination which includes:

"receiving via a programming interface an illumination command that specifies the predetermined illumination;

applying light of an initial intensity level derived from the predetermined illumination to the object;

sensing a total illumination on the object resulting from applying the initial intensity level light;

determining a corrected intensity level from the initial intensity level and the total illumination; and

reapplying light of the corrected intensity level so as to illuminate the object with the predetermined illumination." (emphasis added)

As explained above with regard to claim 13, selection of the predetermined illumination in the Edgerly reference is performed in a manual, rather than programmatic, manner. Significantly, the Edgerly reference says nothing about receiving via a programming interface an illumination command that specifies the predetermined illumination, as recited in Applicants' claimed invention. Therefore, the novel features of the present invention are not

anticipated by the Edgerly reference in that the element of receiving via a programming interface an illumination command that specifies the predetermined illumination is absent from the Edgerly reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Conclusion

Attorney for Applicants has carefully reviewed each one of the cited references, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich
Reg. No. 41,314
Attorney for Applicant(s)
Telephone: (858) 547-9803

Date: 3/14/05

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400